

Remarks

Claims and Specification Status:

Claims 1-20 remain pending in the application. Claim 1 is amended in an editorial manner and without prejudice, and not in response to the art or any formal requirement. No change in claim scope is intended. These amendments will merely facilitate even better discussion of the claim. Claims 4 and 9 are also amended without prejudice as discussed below.

A New Abstract is provided herewith per the Examiner's suggestions on page 3, paragraph 3.

Formal Rejections:

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. We respectfully disagree. Nevertheless, we have broadened claim 4 in the above amendment section. Support for this feature can be found throughout the specification including, e.g., page 50, line 13 – page 53, line 6 and Fig. 9; Figs. 7 & 8 and related specification text, and, e.g., page 54, line 8 – page 56, line 29 and Figs. 12 & 13. Of course, other support is found throughout the specification and priority documents as well. We respectfully request removal of this rejection. And since no art rejection was made regarding claim 4, it now stands ready for allowance.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite. We respectfully disagree. Nevertheless, claim 9 is amended without prejudice to provide additional clarity by removing the several instances of the term “read”. We respectfully request removal of this rejection.

Art-Based Rejections:

Claims 1-3, 5-15 and 17-20 stand rejected under EP0650146 (Kodak) in view of U.S. Patent No. 5,613,004 (Cooperman).¹ Claim 9 stands rejected under Kodak, in view

¹ The Office Action appears to contain an error by suggestion that this rejection is a §102(a) “anticipation” rejection. The text of the Office Action, however, uses “obvious”

of Cooperman and in further view of U.S. Patent No. 5,467,447 (Vogel). Claim 16 stands rejected under Kodak, in view of U.S. patent No. 5,475,205 (Behm). We respectfully traverse these rejections.

Claim 1

The Office Action fails to establish a *prima facie* case of obviousness regarding claim 1.

For example, claim 1 recites a processor which receives: i) the digital representation *and, ii) a reference code associated therewith*. The processor i) employs the reference code to retrieve the second authentication information associated therewith from the storage system.

These features, including receiving a reference code and a digital representation, and using the reference code to retrieve the second authentication information are not even addressed in the Office Action. Please see the Office Action on pages 3 & 4, paragraph 6.

Applicant is left to *guess* as to which features, if any, in Kodak were intended to apply to the “reference code” and using the “reference code” to retrieve the second authentication information in the storage system.

But *guessing* deprives Applicants of a fair opportunity to respond on the record.

The Office Action also fails to address which Kodak features are intended to teach or suggest a “digital representation of an object”. Kodak uses a reader 20 to recover information contained on the card 10, i.e., contained on a magnetic stripe. See, e.g., Fig. 1 But is this magnetic stripe information “a digital representation of an object,” as recited in claim 1? Again, Applicants are left to *guess*. And *guessing* deprives Applicants of a fair opportunity to respond on the record.

Claim 1 further recites iii) employing recovered first authentication information and the second authentication information to determine authenticity of the digital representation. The Office Action cites to two columns of text for these features, without identifying which elements correspond to the claim features.

language, suggesting that the rejection should be a §103 rejection. This response interprets the rejection as an obviousness rejection.

This approach is contrary to the guidance provided by the MPEP (see, e.g., MPEP 706.02(j)). For example:

“[T]he examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate....” See MPEP 706.02(j).

This is because *“[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.”* See MPEP 706.02(j).

We also object to the proposed combination of Kodak and Cooperman. The stated reasons to combine the Kodak with Cooperman assumes what it seeks to prove. Please see the Office Action, pages 3-4, lines 8-11 of paragraph 6. That is, the stated reasons assume that one of ordinary skill is in possession of the invention, rather than establishing a rationale for the combination. For example, the final Office Action states that the proposed modification: “would be obvious to one having ordinary skill in the art at the time of the invention to include in the invention of watermarking/embedding in order to make it visually imperceptible.” See *id.* But this reasoning assumes knowledge of the invention, rather than establishing reasons, need or market pressure to make the claimed arrangement. There are no stated reasons that would lead an artisan to the arrangement claimed without use of Applicant’s specification and claim as a guide. Thus, the reasoning is improper and reflects “the distortion caused by hindsight bias.” Please see KSR, slip op. at 17.

We respectfully request removal of the present rejection of claim 1.

Claim 11

Claim 11 recites that the embedded first authentication information is a digital signature embedded as a watermark in a graphic on the analog form.

The same paragraph 6 (of the Office Action) is used to reject claim 11, but there is no discussion of *embedded first authentication information is a digital signature embedded as a watermark in a graphic on the analog form* in paragraph 6.

The Office Action fails to establish a *prima facie* case of evidence for this claim as well.

Claim 18

Claim 18 recites that the analog form includes an image in which the first authentication information is embedded.

The same paragraph 6 (Office Action) is used to reject claim 18, but there is no discussion of *the analog form includes an image in which the first authentication information is embedded* in paragraph 6.

The Office Action fails to establish a *prima facie* case of evidence for this claim as well.

Claim 20

We respectfully refer the Examiner to our remarks regarding claim 1, above. Claim 20 recites a combination of acts that are generally analogous to the features discussed above under claim 1. But, of course, limitations and features not present in claim 20 should not be read in from claim 1.

The rejection of claim 20 should be removed for at least reasons that are analogous to those discussed above with respect to claim 1.

Claim 3

Claim 3 recites the apparatus set forth in claim 1 where a key is stored in the storage system and associated with the reference code; and the processor further employs the reference code to retrieve the key; and the authentication information reader uses the key to read the first authentication information.

We see no discussion of a key, nor using a key obtained from the storage system to read the first authentication information in the cited Kodak passage.

The rejection of claim 3 should be removed.

Claim 8

Claim 8 recites that a source receives the reference code from a user of the source.

The Office Action cites to a PIN number supplied by a user. See the Office Action at paragraph 12, page 4.

Recall that in the context of claim 8 (and base claim 1) the reference code is used to obtain authentication information from a storage system.

We see no nexus between the PIN at Kodak, col. 7, lines 20-25, and any authentication information as claimed.

Moreover, Kodak at Col. 7, lines 20-25, teaches away from using user supplied information by stating: “Another advantage is that the cardholder **will not** be required to carry any additional information, such as a PIN number...” (*emphasis added*). This teaches against using user supplied information.

The rejection of this claim should be removed as well.

Claim 10

Claim 10 recites that there is a plurality of the apparatuses in the network; and a given one of the apparatuses uses the *reference code* to route the received digital representation and the reference code to another one of the apparatuses.

Here, the reference code is used to route the digital representation and the reference code to another of the apparatuses.

Recall that in the context of claim 10 (and base claim 1) the reference code is used to obtain authentication information from a storage system.

We see no discussion, neither in the Office Action nor in the cited Kodak passages, of a code that is used both for routing as claimed and to access information from a storage system.

The rejection of claim 10 should be removed as well.

Claim 12

The Office Action has failed to establish a *prima facie* case of obviousness regarding claim 12.

For example, the Office Action merely regurgitates its rejection of claim 1, and labels it as a claim 12 rejection. This is transparent since the rejection mentions a processor and second authentication information. See the Office Action, page 5, paragraph 14. While these features are recited in claim 1, they are not recited in claim 12.

Applicant deserves a fair opportunity to respond on the record. But the rejection does not even consider the claim language recited in claim 12. Surely, the Office Action has failed to establish a prima facie case of obviousness since it has not even considered the features of claim 12.

This rejection should be removed.

Claim 14

Claim 14 recites that the reference code is sent in association with but not as part of the digital representation.

The Office Action cites to the User PIN. See the Office Action, page 4, paragraph 12.

This citation is interesting because the cited Kodak passage (Col. 7, lines 20-25) *teaches away* from using user supplied information by stating: “Another advantage is that the cardholder **will not** be required to carry any additional information, such as a PIN number...” (*emphasis added*).

The rejection of claim 14 should be removed.

Claim 15

Claim 15 recites that the verification system employs the reference code to locate a key that is required to read the first authentication information.

We see no discussion of a key, nor using a reference code to locate a key that is required to read the first authentication information in the cited Kodak passage (Col. 3, lines 21-34).

The rejection of claim 15 should be removed.

Claim 19

Claim 19 recites that the analog form is a photo ID, the image is the photo ID's photo, and the reference code is an identification number for the photo ID.

The Office Action cites to Col. 2, lines 16-19, Col. 4, lines 31-33 and Col. 4, lines 34-38 as meeting these features. See the Office Action, page 5, paragraph 16.

But these passages do not mention an identification number of the photo ID as a reference code. *In fact* we do not even see mention of an identification number in the cited passages.

The rejection of claim 19 should be removed.

Claim 9

We respectfully traverse the rejection of claim 9. The Office Action reaches for a third reference, Vogel, to cure the deficiencies of Kodak and Cooperman. We need not discuss the many deficiencies of this proposed combination since Kodak and Cooperman fail to render obvious base claims 1, 5 and 6. But we reserve our right to do so in the future.

The rejection of claim 9 should also be removed.

Claim 16

We respectfully traverse the rejection of claim 16.

The Office Action only rejects claim 16 over Kodak and Behm. See the Office Action, pages 6-7, paragraphs 19 and 20.

The claim 16 rejection is internally inconsistent with the rejection of base claim 12. Please see the Office Action, page 5, paragraph 14. The Office Action stated that Kodak was deficient regarding the base claim, and pulls in Cooperman to fill the gaps.

Since claim 16 depends from claim 12, and since the Office Action admitted that Kodak – alone – was deficient to reject claim 12, the rejection of claim 16 over Kodak and Behm is improper. This is especially true since the Office Action failed to state whether Behm was also relied on to cure Kodak's stated deficiencies mentioned in the rejection of claim 12.

The rejection of claim 16 should be reversed.

Remaining Claims

The remaining claims are also believed to recite patentable combinations. Favorable consideration is respectfully requested.

Request for Interview:

The undersigned respectfully requests an in-person interview with the Examiner. The Examiner is respectfully invited to contact the undersigned to schedule an interview when this Amendment is picked up for consideration, if one has not already been scheduled by the undersigned.

A Final Rejection will be Improper:

Since the Office Action failed to establish a *prima facie* case of obviousness by omitting discussion of many claim elements, and in some cases failing to even discuss the claim itself (i.e., claim 12), the next Office Action can not properly be made final.

Conclusion:

Withdrawal of the above-noted rejections is respectfully requested. We look forward to our upcoming interview; And, in the meantime, the Examiner is invited to contact the undersigned with any questions.

Date: August 28, 2007

CUSTOMER NUMBER 23735

Phone: 503-469-4800

FAX: 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By: /Steven W. Stewart, Reg. No. 45,133/

Steven W. Stewart

Registration No. 45,133